

S/N 10/697,788

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Michael J. BULLINGER	Examiner:	Phi Dieu Tran A
Serial No.:	10/697,788	Group Art Unit:	3637
Filed:	October 30, 2003	Docket No.:	10226.0010US11
Customer No.	23552	Confirmation No.	1146
Title:	GUTTER AND COVER SYSTEM		

APPELLANT'S BRIEF ON APPEAL

Mail Stop APPEAL BRIEF-PATENTS
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450



Sir:

This Brief is presented in support of the Appeal filed April 15, 2011, from the final rejection of claims 8-25, 28 and 29 of the above-identified application, as set forth in the Final Office Action of October 15, 2010.

Payment is made by credit card in the amount of \$270.00 to cover the required fee for a small entity.

An oral hearing is requested. A separate request for oral hearing with the appropriate fee will be filed within two months of the Examiner's Answer.

I. REAL PARTY OF INTEREST

The real party of interest is Eastside Machine Company, Inc. by way of assignment recorded on March 11, 2003 at Reel 013823 and Frame 0375.

II. RELATED APPEALS AND INTERFERENCES

There are no related appeals and interferences. An Appeal was previously filed on May 30, 2007, but prosecution was reopened when a rejection was issued under 35 U.S.C. § 112, second paragraph, with regard to originally filed language in the claim.

A second appeal was also filed on September 17, 2009 but prosecution was again reopened for new § 112 rejections.

III. STATUS OF CLAIMS

Claims 8-25 and 28-29 are pending. Claims 8-25 and 28-29 have been rejected and are the subject of the Appeal. All of the pending claims are listed in the Claims Appendix that follows.

Claims 8, 11 and 13-21 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Knudson, U.S. Patent No. 5,845,435.

Claim 10 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Knudson, U.S. Patent No. 5,845,435 in view of Middleby, U.S. Patent No. 4,263,756.

Claim 12 stands rejected over 35 U.S.C. § 103(a) as being unpatentable over Knudson in view of Wade, U.S. Patent No. 5,729,931 and Richard, U.S. Patent No. 6,732,477.

Claims 9, 22, 24, 28 and 29 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Knudson in view of Beam, U.S. Patent No. 4,604,837.

Claims 23 and 25 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Knudson in view of Beam.

IV. STATUS OF AMENDMENTS

An Amendment has not been filed after the Final Office Action.

V. SUMMARY OF THE CLAIMED SUBJECT MATTER

A summary of the claimed invention follows. The summary includes references to an embodiment disclosed in the specification.

Independent claim 8 is directed to a seamless gutter and cover system 110 shown in Figure 8. A gutter 124 formed from the first coil of material has a front face 119, a bottom 115 and a rear portion 117 extended upward to a top segment. A cover 122 is formed from the second coil of material. The cover 122 extends over the gutter 124 and has a debris separation portion 112, extending above the front face of the gutter, and a lip portion 114 extending upward and wrapping over the top segment of the gutter. The top segment of the gutter 124 and the flange portion of the gutter are continuously crimped together along the entire length to interlock top segment of the gutter to the flange portion of the cover. The lip portion 120 of the cover 122 and a top segment of the rear portion 117 of the gutter 124 are pressed together along their entire length to form an integral gutter and cover assembly 110. See page 7, lines 16 – page 8, line 2.

Independent claim 22 is directed to a seamless gutter and cover system 110 as shown in Figure 8. A gutter 124 has a front face 119 including a curving front portion 120 extending rearward and downward, a bottom 115 and a rear portion 117 extending upward to a top segment. An integral cover 122 extends over the gutter, having a curving front portion 125 extending downward above the front face of the gutter, a concave pooling portion or energy dispersing portion 118 intermediate the rear portion 117 of the gutter with a curving front portion of the gutter 125. A lip portion 114 extends upward and wraps over the top segment 117 of the gutter. The lip portion 114 and the top segment 117 are continuously crimped together along their entire length to join the cover and the gutter to form an integral gutter and cover assembly 110. This is described at page 7, line 16 – page 8, line 2.

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Whether claims 8, 11, 13-21 are anticipated by Knudson, U.S. Patent No. 5,845,435.

Whether claim 10 is unpatentable over Knudson, U.S. Patent No. 5,845,435 in view of Middleby, U.S. Patent No. 4,263,756.

Whether claim 12 is unpatentable over Knudson, U.S. Patent No. 5,845,435 in view of Wade, U.S. Patent No. 5,729,931 and Richard, U.S. Patent No. 6,732,477.

Whether claims 9, 22, 24 and 28-29 are unpatentable over Knudson, U.S. Patent No. 5,845,435 in view of Beam, U.S. Patent No. 4,604,837.

Whether claims 23 and 25 are unpatentable over Knudson, U.S. Patent No. 5,845,435 in view of Beam, U.S. Patent No. 4,604,837.

VII. ARGUMENT

Rejection of claims 8, 10-11 and 13-21 under 35 U.S.C. §102 (b) as being anticipated by Knudson, U.S. Patent No. 5,845,435

Claims 8, 10-11 and 13-16

The Office Action of October 15, 2010 stated that with regard to claim 8, 10-11, and 13-16, *Knudson* shows a seamless gutter and cover system comprising a seamless gutter formed from a first coil of material having a front face, a bottom and rear portion extending upward to a top segment, a cover system having a cover formed from a second coil of material, the cover extends over the gutter and has a debris separation portion extending above the front face of the gutter. A lip portion extends upward and wraps over the top segment of the gutter, the lip portion and the top segment of the gutter are pressed together along their length to form an integral gutter and cover assembly, the interlocking means comprising crimping the top segment of the gutter and the flange portion of the cover together to interlock the top segment of the gutter with the flange portion of the cover. The Action states that the gutter is made of a first material and the cover is made of a second material, the first material being aluminum, the gutter and cover are integrally connected without a connector member, mounting means for securing the system to the edge of the roof, the mounting means further comprising mounting hardware for securing the system to the edge of the roof, the mounting hardware extends through a hole in the gutter and cover system, the mounting system is repeatedly positioned at determined distances along the gutter and cover system.

Applicant respectfully asserts that a close reading of the *Knudson* reference clearly shows that the *Knudson* reference has not been understood and has not been properly characterized in the Office Action. Applicant asserts that *Knudson* neither teaches nor suggests such a seamless gutter and cover system. The Office Action asserts that *Knudson* discloses crimping the top segment of the gutter and the flange portion of the cover together to interlock the top segment of

the gutter with the flange portion of the cover. However, careful reading of *Knudson* reveals that the references does not teach interlocking or crimping. In fact, *Knudson* clearly teaches away from such an integral gutter and cover assembly. As recited in column 4, lines 53-59, *Knudson* recites:

" . . . there is shown a two-piece shielded gutter 92 mounted on support structure 13 having a roof 14. The stationary gutter shown has a semicircular bottom wall 96, a front wall 97 and a back wall 98 forming a U-shaped gutter channel with a top opening. A removable top shield 99 extends downwardly and forwardly from the upper end or top of the back wall 98." (Emphasis added)

Knudson clearly teaches a cover that is **removable** from the gutter assembly, described as removable top shield 99. Applicant asserts that the problem of joining a cover to a gutter integrally is a difficult process, and has not been accomplished by the prior art. Moreover, it is clear that *Knudson* does not teach or suggest such a system. *Knudson* only teaches a hook type element extending over a top edge of another element, but shows no crimping or pressing together and must not include this limitation as the top shield is clearly described as being removable. Reading further, it can be seen that the *Knudson* patent provides further clarification that the cover is a removable cover. Referring to Figure 11 and elements 99a and 98a, *Knudson* recites at column 6, lines 42-48:

"Referring now to FIG. 11, a modified form of separate shield could have a hook 99a at the rear end of the shield opening toward the bottom that would fit down over the upper straight end 98a of the back wall of the gutter so the rear of the shield would attach to the gutter rather than the support device. Otherwise the device 131 and mounting for the shield would be the same as shown in FIGS. 9 and 10." (Emphasis added)

FIG. 11 also shows a removable cover rather than an integral cover and gutter.

Applicant asserts that there is no teaching or suggestion in *Knudson* that the elements are crimped together. Applicant asserts that the Patent Office has improperly inferred a structural limitation that does not exist and which is contrary to the description of the structure. Moreover, Applicant asserts that *Knudson* teaches away from the present invention as the cover must be removable. In addition, Applicant notes that claim 8 recites that the lip portion and the top segment of the gutter are pressed together along their length to form an integral gutter and cover assembly. Not only does *Knudson* not teach that the gutter and cover assembly are crimped together forming an integral gutter and cover assembly, but *Knudson* teaches a removable top shield that cannot be pressed to the gutter assembly along its length as recited in claim 8. Moreover, as the top shield is removable, it is not possible for the cover and gutter to be pressed together.

Although pointed out previously by Applicant, the Office Actions fail to address the language regarding the removable cover. Applicant asserts that the reference must be read and construed in its entirety. It is clear that with a careful reading of the entire reference, the structure cannot be characterized as in the Final Office Action of October 15, 2010.

The present invention provides advantages that are not possible with the prior art, including *Knudson*. The seamless gutter and cover assembly provides for forming a single gutter and cover assembly on the job site from a machine without having to form separate gutters and covers that are then later connected together. Once the gutters and covers have been formed, it is difficult to join them together, even when they are assembled, as access to the long gutter and cover assembly is difficult, especially for portions that are not at the ends of the pieces. The present invention provides a simple and easily installable gutter and cover assembly that is not possible with the prior art. Applicant asserts that claim 8 distinguishes over *Knudson*.

Moreover, claims 10-11 and 13-16 also patentably distinguish over *Knudson* for at least the same reasons. Regarding claims 17-21, Applicant asserts that *Knudson* neither teaches nor suggests the integral gutter and cover system as discussed above with regard to claim 8, and further comprising the support member of such an integral system. The present invention as recited in claims 17-21 provides for an integrally connected gutter and cover assembly with support members that are slid into position. Applicant asserts that *Knudson* does not anticipate such a gutter and cover assembly. Applicant asserts that claims 17-21 are allowable over *Knudson* for the reasons discussed above with regard to claim 8.

Rejection of claim 10 under 35 U.S.C. §103(a) as being unpatentable over Knudson, U.S. Patent No. 5,845,435 in view of Middleby, U.S. Patent No. 4,263,756

Claim 10

The Office Action of October 15, 2010 stated that *Knudson* shows a gutter formed from a first coil of material having a front face, a bottom and rear portion extending upward to a top segment, a cover formed from a second coil of material, wherein the cover extends over the gutter and has a debris separation portion extending above the front face of the gutter, the top segment and the lip portion interlock. The Office Action states that *Knudson* does not show the top segment of the gutter and the flange/lip portion of the cover are continuously crimped together to interlock the top segment with the flange/lip portion. However, the Office Action states that *Middleby* discloses continuous crimping of a panel edge with a gutter recess to assemble the structures together. The Final Office Action states that it would have been obvious to combine *Knudson* with *Middleby*.

For the contention that *Middleby* teaches continuous crimping, the Office Action cites column 1, lines 60-64 of *Middleby*, which only states that that assembly may be effected by crimping. *Middleby* and *Knudson* both fail to disclose or suggest a top segment of the gutter and the flange portion of the cover are **continuously** crimped together to interlock the top

segment of the gutter with the flange portion of the cover. Moreover, the position of the recess 15 and lip 16 in *Middleby* are in a middle area of the bottom of a gutter. Claim 10 has continuous crimping of a top segment of the gutter and the flange portion of the cover. The relative positions of the top segment and the flange at an interior of the gutter and cover assembly make it much more difficult to continuously crimp them together. Conversely, the *Middleby* building element has the lip 16 protruding downward. The nature of any crimp on an outwardly extending lip is fundamentally different than crimping with one side of the portions being crimped at an interior of a gutter and cover assembly, making access and crimping much more difficult and continuous crimping unfeasible.

A key objective of the present invention is to manufacture a continuous integral gutter and cover assembly that can be cut to a desired length. A portable machine allows this to happen at the work site. The gutter and cover are bent and formed with continuous connection along the entire length of the present invention. This structure prevents leaking and eliminates manual assembly at the job site. These problems are inherent in the cited prior art references.

Applicant further asserts that *Knudson* teaches a removable cover as discussed above and suffers from having to be assembled manually in the field and is prone to leaks between the gutter and cover.. A combination of *Knudson* and *Middleby* would arrive at a structure with a protruding lip, but would not overcome the problem of continuously crimping two elements together when one side of the crimped portion is at a difficult to access location at the interior of the assembly. Applicant asserts that the combination does not arrive at the invention recited in claim 10 and a *prima facie* case of obviousness has not been established. Applicant asserts that claim 10 is allowable over the combination of *Knudson* and *Middleby*.

Rejection of claim 12 under 35 U.S.C. § 103(a) as being unpatentable over Knudson, U.S. Patent No. 5,845,435 in view of Wade, U.S. Patent No. 5,729,931 and Richard, U.S. Patent No. 6,732,477.

Claim 12

Claim 12 was rejected under 35 U.S.C. § 103(a) as being unpatentable over *Knudson*, U.S. Patent No. 5,845,435 in view of *Wade*, U.S. Patent No. 5,729,931 and *Richard*, U.S. Patent No. 6,732,477. The Office Action stated that *Knudson* shows all of the limitations except for the first material being aluminum and the second material being copper. The Final Office Action stated that *Wade* shows a cover made of copper and *Richard* shows a gutter made of aluminum and that it would have been obvious to combine the references. Claim 12 depends from claim 11, which depends from claim 8. Claim 8 patentably distinguishes over *Knudson* as discussed above. *Wade* and *Richard* do not overcome the shortcomings of *Knudson*. Applicant therefore asserts that claim 8 patentably distinguishes over the combination of *Knudson*, *Wade* and *Richard* and claim 12 patentably distinguishes over the combination for at least the same reasons. Applicant requests that the rejection of claim 12 under 35 U.S.C. §103 (a) be withdrawn.

Rejection of claims 9, 22, 24 and 28-29 under 35 U.S.C. §103 (a) as being unpatentable over Knudson, U.S. Patent No. 5,845,435 in view of Beam, U.S. Patent No. 4,604,837

Claim 9

The Office Action of October 15, 2010 stated that *Knudson* shows all the claim limitations except for the cover comprising a kinetic energy dispersion section intermediate the rear portion of the gutter and the debris separation portion of the cover. The Final Office Action stated that *Beam* discloses a kinetic energy dispersion section intermediate the rear portion of the gutter and the debris separation portion of the cover to enable the slowing of rain water so that rain water would properly drain into the gutter. The Office Action asserts that it would have

been obvious to one having ordinary skill in the art at the time of the invention to modify *Knudson's* structure to show the cover comprising a kinetic energy dispersion section intermediate the rear portion of the gutter and the debris separation portion of the cover because it would allow for the slowing of rain water so that rain water would properly drain into the gutter as taught by *Beam*. Applicant respectfully traverses the rejection.

As stated above, a careful reading and proper characterization of *Knudson* shows that *Knudson* does not teach or suggest the gutter and cover assembly recited in claim 8, as discussed above. Applicant respectfully asserts that *Beam* fails to overcome those shortcomings of *Knudson*. The combination of *Knudson* and *Beam* fails to teach or suggest the integral cover and gutter assembly, and fails to teach or suggest that the elements are pressed together along their length to form the integral cover and gutter assembly. *Beam* does not teach or suggest such structure. Moreover, *Beam*, when combined with *Knudson* still fails to teach or suggest such structure. Applicant therefore asserts that the combination of *Knudson* and *Beam* fails to establish a *prima facie* case of obviousness with regard to claim 8. Applicant asserts that claim 9 also patentably distinguishes over the combination of *Knudson* and *Beam* for at least the same reasons.

Claims 22, 24, and 28-29

The Office Action of October 15, 2010 stated that *Knudson* shows all the claim limitations, but the Office Action fails to address all of the limitations of claim 22. Claim 22 recites a gutter having a front face, a curving front portion extending rearward and downward, a bottom and a rear portion extending upward to a top segment. Moreover, claim 22 recites an integral cover extending over the gutter, having a curving front portion extending downward and rearward above the front face of the gutter. Claim 22 also recites a concave pooling portion intermediate the rear portion of the gutter and the curving portion of the cover, and a lip portion extending upward and wrapping over the top segment of the gutter. Finally, claim 22 recites that

the lip portion and the top segment of the gutter are pressed together along their length to form an integral gutter and cover assembly. As discussed above with regard to claim 8, *Knudson* fails to teach or suggest the recited structure. *Knudson* teaches a **removable** top shield and fails to disclose the lip portion and top segment pressed together along their length to form an integral gutter and cover assembly. As discussed above, not only does *Knudson* not teach or suggest such structure, but careful examination of *Knudson* reveals that it teaches a removable top shield, which teaches away from the integral assembly of the present invention. *Beam* fails to remedy these shortcomings of *Knudson*. Applicant asserts that claim 22 therefore patentably distinguishes over *Knudson* and *Beam* for at least reasons similar to those discussed above with regard to claim 8. Moreover, Applicant asserts that claims 24 and 28-29 are also allowable for at least these same reasons.

Rejection of claims 23 and 25 as being unpatentable over Knudson, U.S. Patent No. 5,845,435 in view of Beam, U.S. Patent No. 4,604,837

Claims 23 and 25.

The Final Office Action of October 15, 2010 stated that *Knudson* shows all of the claim limitations of the gutter except a front face defining a K-style or square profile. The Action states that it would have been obvious to one having ordinary skill in the art at the time of the invention to modify *Knudson*'s structure to show the gutter front face defining a K-style or square profile because it would have been an obvious matter of engineering design choice. Applicant respectfully traverses the rejection. Applicant asserts that claim 22 is allowable for at least the reasons discussed above. Applicant asserts that dependent claims 23 and 25 are also allowable for at least the same reasons. Applicant requests that the rejection of claims 23 and 25 therefore be withdrawn.

VIII. SUMMARY

Applicant asserts that the claims patentably distinguish over the prior art when the description of the prior art is correctly considered. Applicant requests that the present Petition be granted and that the Examiner's rejections over *Knudson* and the other prior art be reversed, and that the pending claims be allowed.

Please charge any additional fees or credit overpayment to Merchant & Gould Deposit Account No. 13-2725.

Respectfully submitted,

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IX. CLAIMS APPENDIX

1-7. (Cancelled)

8. A seamless gutter and cover system comprising:

 a gutter formed from a first coil of material having a front face, a bottom and a rear portion extending upward to a top segment;

 a cover formed from a second coil of material, wherein the cover extends over the gutter and has a debris separation portion extending above the front face of the gutter, and a lip portion extending upward and wrapping over the top segment of the gutter,

 wherein the lip portion and the top segment of the gutter are continuously pressed and fixed together along their entire length to form an integral gutter and cover assembly.

9. The gutter and cover system according to claim 8, wherein the cover further comprises a kinetic energy dispersion section intermediate the rear portion of the gutter and the debris separation portion of the cover.

10. A seamless gutter and cover system comprising:

 a gutter formed from a first coil of material having a front face, a bottom and a rear portion extending upward to a top segment;

 a cover formed from a second coil of material, wherein the cover extends over the gutter and has a debris separation portion extending above the front face of the gutter, and a lip portion extending upward and wrapping over the top segment of the gutter;

wherein the top segment of the gutter and the flange portion of the cover are continuously crimped together along their entire length to interlock the top segment of the gutter with the flange portion of the cover.

11. The gutter and cover system of claim 8, wherein the gutter is made of a first material and the cover is made of a second material.

12. The gutter and cover system of claim 11, wherein the first material comprises aluminum and the second material comprises copper.

13. The gutter and cover system of claim 8, wherein the gutter and cover are permanently integrally connected together.

14. The gutter and cover system of claim 8, further comprising mounting means for securing the system to the edge of the roof.

15. The gutter and cover system of claim 14, wherein the mounting means further comprises mounting hardware for securing the system to the edge of the roof, wherein the mounting hardware extends through a hole in the gutter and cover system.

16. The gutter and cover system of claim 15, wherein said mounting means is repeatedly positioned at determined distances along said gutter and cover system.

17. The gutter and cover system of claim 8, further comprising an internal support member for reinforcing the gutter and cover.

18. The gutter and cover system according to claim 17, wherein the internal support member further comprises a debris separation support segment juxtaposed to an underside of the debris

separation portion of the cover and having a profile with an upper edge matching the debris separation portion of the cover, and a rear portion extending downward to a front face segment.

19. The gutter and cover system described in claim 18, further comprising fixation means for securing the internal support member with respect to the gutter and cover system.

20. The system of claim 19, wherein the fixation means further comprises mounting hardware for securing the internal support member to the gutter and cover system, wherein the mounting hardware extends through a hole in the gutter and into a hole in the debris separation support segment.

21. The system according to claim 20, wherein the internal support member is repeatedly positioned at determined distances along said gutter and cover system.

22. A seamless gutter and cover system comprising:

a gutter having a front face, a curving front portion extending rearward and downward, a bottom and a rear portion extending upward to a top segment;

an integral cover extending over the gutter, having a curving front portion extending downward and rearward above the front face of the gutter, a concave pooling portion intermediate the rear portion of the gutter and the curving front portion of the cover, and a lip portion extending upward and wrapping over the top segment of the gutter,

wherein the lip portion and the top segment of the gutter are continuously pressed together along their entire length to join the cover and the gutter and form an integral gutter and cover assembly.

23. The system described in claim 22, wherein said front face defines a K-style profile.
24. The system described in claim 22, wherein said front face defines a continuously curved profile.
25. The system described in claim 22, wherein said front face defines a substantially square profile.
- 26-27. (Cancelled)
28. The gutter and cover system according to claim 9, wherein the kinetic energy dispersion section comprises a pooling section.
29. The gutter and cover system according to claim 28, further comprising an internal support member having a pooling segment profile juxtaposed to an underside of the pooling section of the cover, and a rear portion extending downward to a front face segment.

X. EVIDENCE APPENDIX

A. OFFICE ACTIONS AND AMENDMENTS/RESPONSES

1. Office Action dated October 6, 2005
2. Amendment filed March 6, 2006
3. Final Office Action dated May 30, 2006
4. Notice of Appeal filed November 30, 2006
5. Appellant's Brief on Appeal filed May 30, 2007
6. Office Action dated December 12, 2007
7. Amendment filed June 12, 2008
8. Final Office Action dated October 17, 2008
9. Notice of Appeal filed April 17, 2009
10. Appellant's Brief on Appeal filed September 17, 2009
11. Notification of Non-Compliant Appeal Brief dated October 9, 2009
12. Communication Regarding Non-Compliant Appeal Brief filed November 9, 2009
13. Office Action dated January 28, 2010
14. Amendment filed July 28, 2010
15. Final Office Action dated October 15, 2010
16. Notice of Appeal filed April 15, 2011.

B. REFERENCES RELIED UPON BY THE EXAMINER

Knudson, U.S. Patent No. 5,845,435

Manoogian Jr., U.S. Patent No. 5,072,551

Middleby, U.S. Patent No. 4,263,756

Wade, U.S. Patent No. 5,729,931

Richard, U.S. Patent No. 6,732,477

Beam, U.S. Patent No. 4,604,837

C. REFERENCES CITED BY APPELLANTS

Knudson, U.S. Patent No. 5,845,435

Manoogian Jr., U.S. Patent No. 5,072,551

Middleby, U.S. Patent No. 4,263,756

Wade, U.S. Patent No. 5,729,931

Richard, U.S. Patent No. 6,732,477

Beam, U.S. Patent No. 4,604,837

D. CASES CITED IN THE BRIEF

None.

XI. RELATED PROCEEDINGS APPENDIX

- A. Notice of Appeal filed November 30, 2006
- B. Appellant's Brief on Appeal filed May 30, 2007
- C. Notice of Appeal filed April 17, 2009
- D. Appellant's Brief on Appeal filed September 17, 2009